

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BLAKE B. BOGRETT,
ROBERT J. ALLWEIN and LARRY J. WEINSTEIN

Appeal 2006-0899
Application 09/912,290
Technology Center 1700

Decided: September 28, 2006

Before KIMLIN, PAK, and WARREN, *Administrative Patent Judges*.
PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's refusal to allow claims 1 through 9. Claims 10 through 18, the other pending claims in the above-identified application, stand withdrawn from consideration by the Examiner as being directed to a non-elected invention. We have jurisdiction pursuant to 35 U.S.C. § 134.

I. APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a resilient fibrous insulation batt such as that shown in Figure 6 of the subject application. See Specification at 5-6, together with claim 1. This fibrous insulation batt is cut from a fibrous insulation blanket made from fibrous webs, such as the one shown in Figure 5 of the subject application. See Specification at 6. Details of the appealed subject matter depicted in Figure 6 are recited in claim 1 which is reproduced below:

1. A resilient fibrous insulation batt consisting essentially of:

a single blanket of resilient fibrous insulation having no folds therein; the blanket having a length, a width and a thickness; the length of the blanket being a longest dimension of the blanket; the thickness of the blanket being a shortest dimension of the blanket; the width of the blanket being a dimension of the blanket intermediate the length and the thickness of the blanket in magnitude; the blanket having first and second major surfaces that, with respect to each other, lie in substantially parallel planes and that each extend the length and width of the blanket; the blanket having first and second lateral surfaces that, with respect to each other, lie in substantially parallel planes, that extend for the length of the blanket, and that extend between the major surfaces of the blanket; the blanket having first and second end surfaces that, with respect to each other, lie in substantially parallel planes, that extend the width of the blanket, and that extend between the major surfaces of the blanket; the fibers of the blanket being randomly oriented and entangled together and predominately lying in planes that extend substantially perpendicular to the planes of the major surfaces and the end surfaces of the blanket and substantially parallel to the planes of the lateral surfaces of the blanket to facilitate a widthwise compression of the blanket.

II. PRIOR ART

As evidence of unpatentability of the claimed subject matter, the Examiner relies upon the following references:

Brandt et al. (Brandt) WO 94/16162 July 21, 1994
(Published International Patent Application)

Michelsen US 5,765,318 June 16, 1998

III. REJECTION

The claims on appeal stand rejected as follows:

1. Claims 1 through 9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;
2. Claims 1, 2, 4, and 5 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Brandt; and
3. Claims 3, and 6 through 9 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Brandt and Michelsen.

IV. FACTUAL FINDINGS AND CONCLUSIONS

We have carefully considered the claims, specification and prior art references, including the arguments advanced by both the Appellants and the Examiner in support of their respective positions. This review has led us to conclude that only the Examiner's §§ 102 and 103 rejections set forth in the Answer are well-founded. Accordingly, we will only sustain the Examiner's decision rejecting the claims on appeal under §§ 102 and 103 for the factual findings and conclusions set forth in the Answer. We will not sustain the Examiner's § 112 rejection. Our reasons for these determinations follow.

1. WRITTEN DESCRIPTION

With respect to the description requirement under 35 U.S.C. § 112, first paragraph, the court stated in *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983) that:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.... The content of the drawings may also be considered in determining compliance with the written description requirement (citation omitted).

Applying *Kaslow* to the present situation, we determine that the specification as originally filed describes the negative limitation “a single blanket of resilient fibrous insulation having no folds” recited in claims 1 through 9 within the meaning of 35 U.S.C. § 112, first paragraph. Specifically, we find that the specification as originally filed describes a resilient fibrous insulation batt made from a single resilient fibrous insulation blanket in reference to Figures 5 and 6 of the application. See specification at 5-6. While Figure 5 depicts a single resilient fibrous insulation blanket, Figure 6 illustrates a resilient fibrous insulation batt having no folds. We find that these disclosures as a whole would have reasonably conveyed to one of ordinary skill in the art that the Appellants had possession of a resilient fibrous insulation batt having no folds. *In re Anderson*, 471 F.2d 1237, 1244, 176 U.S.P.Q. 331, 336 (C.C.P.A. 1973); *Ex parte Parks*, 30 U.S.P.Q.2d 1234, 1236-37 (Bd. Pat. App. & Int. 1993).

The Examiner relies on *Ex parte Grasselli*, 231 U.S.P.Q. 393, 394 (Bd. Pat. App. & Int. 1983) to support his position that “[n]egative limitations are not allowed unless expressly set forth in the specification.” See Answer at 3. However, the Examiner’s interpretation of *Grasselli* is misplaced. In the first place, such interpretation is inconsistent with current

jurisprudence which does not require an express written descriptive support. *See Kaslow*, 707 F.2d at 1375, 217 U.S.P.Q. at 1096 (“The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.”); *In re Wertheim*, 541 F.2d 257, 265, 191 U.S.P.Q. 90, 98 (C.C.P.A.). (In order to satisfy the written description requirement, the application disclosure as originally filed does not have to provide in *haec verba* support for the claimed subject matter at issue.). In the second place, *Grasselli* is limited to a situation where a negative limitation introduces a new concept in violation of the written description requirement of the first paragraph of 35 U.S.C. § 112. *See Grasselli*, 231 U.S.P.Q. at 394, *citing Anderson*, 471 F.2d at 1244, 176 U.S.P.Q. at 336.

Having determined that the Examiner has not demonstrated that the application disclosure as originally filed does not reasonably convey to one of ordinary skill in the art the claimed subject matter at issue, we reverse the examiner’s decision rejecting of claims 1 through 9 under 35 U.S.C. § 112, first paragraph, based on written description.

2. ANTICIPATION

As set forth in *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 U.S.P.Q.2d 1030, 1032 (Fed. Cir. 1997):

Under 35 U.S.C. §102, every limitation of a patent claim must identically appear in a single prior art reference for it to anticipate the claim.

In other words, anticipation requires that claims 1, 2, 4 and 5 on appeal "read on" something disclosed in the single prior art reference. *See Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983).

Here, we concur with the Examiner that claims 1, 2, 4, and 5 read on something described in Brandt. We find that Brandt illustrates an intermediate mineral fiber insulation product (which may be formed from cutting a mineral fiber insulation web through imaginary lines 20 and 22 (thus, removing folds)) and a mineral fiber insulation products employing such intermediate product. See Figures 8, 9, 10, and 11 in conjunction with page 29. We find that the claims embrace either the intermediate or final fiber insulation product described and illustrated in Brandt. Compare, e.g., Brandt's Figures 8 and 9 with Figure 6 of the subject application. Specifically, as found by the Examiner at pages 3 and 4, Brandt's intermediate fiber insulation product having no folds employed in the final insulation product corresponds to the claimed resilient fibrous insulation batt.

Rather than challenging the Examiner's every factual finding at pages 3 and 4 of the Answer, the Appellants focus only on the two claimed features. See Brief at 7-9. That is, the Appellants only argue that Brandt does not teach or suggest the claimed randomly oriented and entangled fibers and the claimed direction of such fibers with respect to the planes of the major, end and lateral surfaces. *Id.* We do not agree.

First, we find nothing in the specification, which would distinguish the claimed blanket made of randomly oriented and entangled fibers from the mineral fiber insulation web described in Brandt. (See the specification

in its entirety.) Rather, we find that the mineral fiber insulation web described in Brandt, like the Appellants' blanket made of randomly oriented and entangled fibers, is formed by expelling or spraying fibers from rapidly rotating spinning-wheels. (Compare Brandt at page 14 with specification at 4.) Second, as found by the Examiner at pages 3, 4, 6, and 7 of the Answer, we find that the fibers of Brandt's web are lying in planes that extend substantially perpendicular to the planes of its two major and end surfaces and substantially parallel to the planes of its two lateral surfaces.¹ See also Brandt's Figures 8-10. Thus, we determine that the claims read on the intermediate mineral fiber-insulation product itself or the final product employing such intermediate product described in Brandt within the meaning of 35 U.S.C. § 102(b).

Accordingly, we affirm the Examiner's decision rejecting claims 1, 2, 4, and 5 under 35 U.S.C. § 102(b).

3. OBVIOUSNESS

As evidence of obviousness of the subject matter defined by claims 3, and 6 through 9 under 35 U.S.C. § 103(a), the Examiner relies on the combined teachings of Brandt and Michelsen. (See Answer at page 4.) According to the Examiner (Answer at 4-5):

It would have been obvious to a person having ordinary skill in the art at the time of the invention to use polymeric fibers in Brandt et al. in order to use fibers that are easier to process and are recyclable... [and] to use a binderless web in the Brandt et al.

¹ According to the Appellants at page 2 of the specification, "substantially perpendicular" and "substantially parallel" include perpendicular and substantially perpendicular, and parallel and substantially parallel, respectively.

insulation in order to provide an insulation material with less weight and increased compressibility...

The Appellants do not dispute this determination made by the Examiner. See Brief at 9. Rather, the Appellants only argue that the earlier-mentioned deficiencies in Brandt are not taught by Michelsen. Thus, for the reasons indicated *supra* and in the Answer, we affirm the examiner's decision rejecting claims 3 and 6 through 9 under 35 U.S.C. § 103.

V. CONCLUSION

The decision of the Examiner is affirmed.

VI. TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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